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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 820,353	03 29 2001	Nobuhito Okumura	2001_0379A	2735

513 7590 11 06 2002

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EXAMINER

MAPLES, JOHN S

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11 06 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/325,963

Applicant(s)

ALBRECHT ET AL.

Examiner

Leanna Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 15 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 13-17, 25-31 and 33-35 is/are rejected.
- 7) ☐ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 13-15, 17, 25-28, 31, 34 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lindquist et al. (USPN 3665918).

**Claims 13-15, 17, 34 and 35:**

Lindquist is directed to breathable pressure-sensitive adhesive tapes comprising thermoplastic polyurethane foams (or styrene-butadiene foams or rubber based foams) having a porous pressure sensitive adhesive applied to one surface and having a porous plastic backing film applied to the opposite surface. The thermoplastic polyurethane foam of Lindquist reads on Applicant's thermoplastic, amorphous polymer and Applicant's foam layer comprised of a pressure sensitive adhesive polymer. The foams of Lindquist are produced as sheets, and therefore, inherently have a major longitudinal surface. Because pores are three-dimensional, they are inherently perpendicular to at least one side of the sheet of foam in which they are a part. Applicant's specification reveals that porosity and breathability are equivalent at Page 3, lines 1-3. Therefore, because Lindquist is a breathable foam and inherently has porosity in a direction perpendicular to at least one major surface, Lindquist also must have breathability in a direction perpendicular to at least one major surface. The foams of Lindquist have a thickness of about 0.001 to 0.025 inches, which reads on Applicant's thickness of about 86 to about 265 microns.

With regard to the process limitations of Claims 13 and 34, the blowing agent claimed by Applicant is not present in the final product and therefore the presence of the blowing agent in the intermediate product is not given patentable weight with regard to

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the final product. Also, it is the examiner's position that the breathable foam of Lindquist is identical to or only slightly different than the breathable foam layer prepared by the method of the claim(s), because both breathable foams may be comprised of the same thermoplastic polyurethane, both have at least one major surface, both inherently have porosity in a direction perpendicular to a major surface, and both breathable foams have thicknesses within the same range. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The breathable foam of Lindquist either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Lindquist.

Lindquist does not specifically disclose the glass transition temperature of their thermoplastic polyurethane foam. However, it appears that thermoplastic polyurethane foam of Lindquist is substantially identical to the presently claimed thermoplastic,

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amorphous polymer foam. Thus, it is believed by the examiner that the glass transition temperature of the thermoplastic polyurethane foam of Lindquist is inherently within Applicant's presently claimed range. Additionally, the presently claimed glass transition temperature would have obviously been present once the thermoplastic polyurethane foam of Lindquist was provided. See *In re Best*, 195 USPQ 433 footnote 4 (CCPA 1977) as to the providing or this rejection under 35 USC 102 as well as 35 USC 103.

Lindquist has at least two layers.

Lindquist does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam. However, it appears that the breathable foam of Lindquist is substantially identical to the presently claimed breathable foam layer. Thus, it is believed by the examiner that the moisture vapor transition rate of the breathable foam of Lindquist inherently increases when stretched. Additionally, the presently claimed moisture vapor transition rate would have obviously been present once the breathable foam of Lindquist is provided. See *In re Best*, 195 USPQ 433 footnote 4 (CCPA 1977) as to the providing or this rejection under 35 USC 102 as well as 35 USC 103.

**Claims 25-28 and 31:**

The thermoplastic polyurethane foam of Lindquist reads on Applicant's breathable, amorphous, thermoplastic foam having at least one major surface, having at least one ruptured cell, and having a thickness of about 86 to about 265 microns, and wherein the foam layer has breathability in a direction perpendicular to a major surface of the foam. With regard to Applicant's "at least one ruptured cell", the examiner has

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interpreted this language to encompass a material that has at least one open cell, or in the case of Lindquist, one reticulated cell. Both the porous adhesive layer of Lindquist and the porous polyolefin film layer of Lindquist can read on Applicant's second layer comprising a polymeric material that is ruptured at, or near, the site of the ruptured cells in the foam layer.

With regard to the process limitation of Claim 26, It is the examiner's position that the adhesive sheet of Lindquist is identical to or only slightly different than the article comprising at least two layers prepared by the method of the claim(s), because both both are comprised of a breathable, amorphous, thermoplastic foam having at least one major surface, having at least one ruptured cell, and having a thickness of about 86 to about 265 microns, and wherein the foam layer has breathability in a direction perpendicular to a major surface of the foam, and both have a second layer comprising a polymeric material that is ruptured at, or near, the site of the ruptured cells in the foam layer. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The adhesive sheet of Lindquist either anticipated or strongly suggested the claimed subject matter. It is noted

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that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Lindquist.

The porous adhesive layer of Lindquist and the porous polymeric film layer of Lindquist are both unfoamed. The styrene-butadiene foams of Lindquist read on Applicant's foam layer comprised of a thermoplastic elastomer. Lindquist discloses a moisture vapor transition rate of 53 grams per 100 square inches per 24 hours. This reads on Applicant's claimed moisture vapor transition rate greater than 300 grams per square meter per 24 hours.

4. Claims 13-17 and 34-35 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walther (USPN 5905097).

Walther is directed to the production of breathable foams comprised of styrene-butadiene block copolymers (Example 5). This reads on Applicant's specific thermoplastic, amorphous polymer and Applicant's foam layer comprised of a pressure sensitive adhesive polymer. The foams of Walther are produced as sheets, and therefore, inherently have a major longitudinal surface. Because pores are three-dimensional, they are inherently perpendicular to at least one side of the sheet of foam in which they are a part. Walther discloses thicknesses between about 76 and about 305 microns (Example 4 Table) which are within Applicant's presently claimed range. The glass transition temperature of styrene-butadiene block copolymers is inherently



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less than 20°C. Walther discloses depositing the breathable foam onto a metal surface. This reads on an article having at least two layers, one of the layers being non-porous.

It is the examiner's position that the breathable foams of Walther are identical to or only slightly different than the breathable foam layer prepared by the method of the claim(s), because both breathable foams may be comprised of the same thermoplastic amorphous styrene-butadiene block copolymer, both have at least one major surface, both inherently have porosity in a direction perpendicular to a major surface, and both breathable foams have thicknesses within the same range. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). Walther either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Walther.

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Walther does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam. However, it appears that the breathable foam of Walther is substantially identical to the presently claimed breathable foam layer. Thus, it is believed by the examiner that the moisture vapor transition rate of the breathable foam of Walther inherently increases when stretched. Additionally, the presently claimed moisture vapor transition rate would have obviously been present once the breathable foam of Walther was provided. See *In re Best*, 195 USPQ 433 footnote 4 (CCPA 1977) as to the providing or this rejection under 35 USC 102 as well as 35 USC 103.

5. Claims 29, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist et al. (3665918) in view of Pufahl (USPN 4169184).

As set forth above, Lindquist teaches a breathable thermoplastic foam layer B having at least one major surface having at least one ruptured cell having a thickness of about 86 to about 265 microns, and having breathability in a direction perpendicular to a major surface of the foam. Lindquist also teaches applying a porous pressure-sensitive adhesive coating to one side of the breathable thermoplastic foam layer B. The porous pressure-sensitive adhesive of Lindquist reads on Applicant's A layer comprised of an unfoamed material that is ruptured at, or near, the site of the ruptured cells in the foam layer. Lindquist discloses the use of styrene-butadiene foams, which reads on Applicant's thermoplastic elastomer B layer.

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Lindquist, however, does not disclose an ABA structure. Pufahl is directed to an adhesive tape comprising a flexible, open-cell polyurethane foam having pressure-sensitive adhesives applied to both surfaces of the foam. This reads on Applicant's ABA structure. Therefore, it would have been obvious to the skilled artisan at the time this invention was made to combine the teachings of Lindquist and Pufahl because it is well-known in the art of adhesive tapes, to apply pressure-sensitive adhesive layers to both sides of a backing material.

Lindquist does not disclose applying a material to at least one A layer. Pufahl teaches applying a release tape to the outer surface of their pressure-sensitive adhesive layer. The release tape of Pufahl prevents the adhesive from sticking to undesired materials prior to use. Therefore, it would have been obvious to the skilled artisan at the time this invention was made to apply a release liner to the pressure-sensitive adhesive layer A of Lindquist, motivated by the desire to prevent the adhesive tape from sticking to itself or another undesired object during storage, or prior to use.

### ***Allowable Subject Matter***

6. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art teaches Applicant's claimed ABA structure, but does not disclose applying a pressure-sensitive adhesive layer to a major surface of at least one A layer. There is no obvious suggestion to apply an additional

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pressure sensitive adhesive layer to the pressure sensitive adhesive A layers of the prior art.

### ***Response to Arguments***

7. Applicant's arguments filed June 25, 2002 have been entered and carefully considered.

8. With regard to the rejection over Walther, Applicant contends: "Walther does not disclose an extruded single layer foam, or a multi-layer foam that is ruptured at or near, the sites of ruptured cells in the foam layer". These arguments are not found persuasive because as explained above, the patentability of a product does not depend on its method of production. Additionally, Claims 13-17 and 34-35 do not require a multi-layer foam that is ruptured at or near the sites of ruptured cells in the foam layer.

9. Applicant's arguments with respect to the rejections over Volke, Cilento, Chen, Bello, and Tenneco Chemicals, Inc. have been considered but are moot in view of the new ground(s) of rejection.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr

November 1, 2002



TERREL MORRIS  
SUPERVISOR, ART UNIT 1771  
EXAMINER